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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER	
SHELEHEDA, JAMES R	
ART UNIT	**PAPER NUMBER**
2623	

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11/26/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	09/760,242	DAVIDSON, ROBERT J.	
	Examiner	Art Unit	
	James Sheleheda	2623	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *31 October 2007*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-32* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-32* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 10/31/07 has been entered.

Response to Arguments

2. Applicant's arguments filed 10/31/07 have been fully considered but they are not persuasive. On pages 9-11, of applicant's response, applicant argues that Downs fails to disclose "a predefined limit of authorized playings of the entertainment media" as claimed, as the End User Player Application of Downs resides in the End User Device and not the portable device.

In response, Downs specifically discloses wherein the portable device will have computer software, *providing a portion of the End User Player Application's functionality*, stored thereon for controlling access to the entertainment media (column 7, lines 11-22 and column 11, lines 30-55). These instructions provide a predefined limit of authorized playings of the entertainment media (column 7, lines 2-8 and lines 41-55). Thus the digital storage module (disclosed in Chung) is encoded with access

instructions (i.e. the computer program reading/writing watermark information) controlling access to the entertainment media (limiting the number of playbacks of the content). Therefore, applicant's arguments are not convincing. While applicant argues that Downs does not teach or suggest that the portable device will updated the watermark, it is noted that Downs specifically indicates that "The portable consumer device will perform a subset of the End User Player Applications functions in order to process the content's Usage Conditions embedded in the watermark" (column 11, lines 49-52). As one of the specific functions embedded in the watermark is limiting of the number of playbacks of the content based upon the Usage Conditions and updating the watermark according (column 7, lines 2-8 and lines 40-55), applicant's arguments are not convincing. Any inability to update the watermark based upon the usage of the content would make the system incapable of limiting the number of playbacks, as desired by Downs.

3. Applicant's arguments regarding claims 9, 10 and 15, in view of Yamagata, have been considered but are moot in view of the new grounds of rejection.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claims 9-15 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The limitation of a "pocket-size enclosure", as recited in claim 9, is not supported by the specification as originally filed. While the cited section of the specification indicates that storage device is "subminiature in size" and "within a small housing", there is no specific support for the language of pocket size or a pocket size enclosure.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

7. Claims 1-5, 8, 16-21, 23-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chung (6,628,963) (of record) in view of Downs et al. (Downs) (6,226,618) (of record).

As to claim 1, while Chung discloses a method of portably handling entertainment media (column 1, lines 5-12) comprising:

storing entertainment media in a memory of a portable digital storage module (column 1, lines 37-40, column 2, line 56-column 3, line 20);

retrieving the entertainment media from the memory of the portable digital storage module with a digital format player device (Fig. 2; column 2, line 56-column 3, line20), he fails to specifically disclose encoding the portable digital storage module with access instructions corresponding to a predefined limit of authorized playings of the entertainment media and retrieving the entertainment media in accordance with a permission granted by the access instructions.

In an analogous art, Downs discloses a content delivery system (see Figs. 1A-D) wherein digital content is downloaded onto a portable media player (column 6, lines 35-48) which is encoded with access instructions corresponding to a predefined limit of authorized playings of the entertainment media (column 11, lines 30-55 and column 7, lines 41-55) to allow retrieval of the entertainment media in accordance with a permission granted by the access information (column 11, lines 30-55) for the typical benefit of ensuring that the rights of content owners are secured in a digital content distribution system (column 1, lines 50-60 and column 2, lines 26-34).

It would have been obvious to one of ordinary skill in the art at the time of invention by applicant to modify Chung's system to include encoding the portable digital storage module with access instructions corresponding to a predefined limit of authorized playings of the entertainment media and retrieving the entertainment media in accordance with a permission granted by the access instructions, as taught by Downs, for the typical benefit of ensuring that the rights of content owners are secured in a digital content distribution system.

As to claim 2, Chung and Downs disclose wherein the storing step further comprises transferring a copy of the entertainment media from a purchase center into the memory of the portable digital storage module (electronic digital content stores; see Downs at column 10, lines 4-35).

As to claim 3, Chung and Downs disclose wherein the storing step further comprises downloading the entertainment media from a remotely located database (see Downs at column 10, lines 4-35).

As to claim 4, Chung and Downs disclose repeating the storing step to store two or more entertainment media into the memory of the portable digital storage module (downloading and storing a plurality of movie files; see Chung at column 1, lines 5-12, lines 37-40 and column 2, lines 55-62).

As to claim 5, Chung and Downs disclose wherein the retrieving step further comprises the player device including a personal movie player (portable multimedia player; see Chung at Figs. 1 and 2; column 1, lines 20-30).

As to claim 8, Chung and Downs disclose wherein the storing step and the retrieving step are performed in a broadband frequency format (MPEG format; see Chung at column 2, line 35 - column 3, line 11).

As to claim 16, while Chung discloses a portable digital media handling system (column 1, lines 5-12), comprising:

a system configured to receivingly engage a portable digital storage module in a data transfer relationship (column 1, lines 37-40, column 2, line 56-column 3, line 20), to operably store a user-selected entertainment media to the portable digital storage module (column 1, lines 37-40, column 2, line 56-column 3, line 20) and accessing the entertainment media by a digital format player device (Fig. 3; column 2, line 40-column 3, line 20), he fails to specifically disclose a purchase system and storing access instructions associated with a predefined limit of authorized playings of the user-selected entertainment media via the portable digital storage module in order to prevent unauthorized access to the entertainment media by the digital format player device.

In an analogous art, Downs discloses a content delivery system (see Figs. 1A-D) wherein purchased digital content is downloaded onto a portable media player (column 6, lines 35-48) which is encoded with access instructions corresponding to a predefined limit of authorized playings of the entertainment media (column 11, lines 30-55 and column 7, lines 41-55) to allow retrieval of the entertainment media in accordance with a permission granted by the access information (column 11, lines 30-55) for the typical benefit of ensuring that the rights of content owners are secured in a digital content distribution system (column 1, lines 50-60 and column 2, lines 26-34).

It would have been obvious to one of ordinary skill in the art at the time of invention by applicant to modify Chung's system to include purchase system and storing access instructions associated with a predefined limit of authorized playings of the user-

selected entertainment media via the portable digital storage module in order to prevent unauthorized access to the entertainment media by the digital format player device, as taught by Downs, for the typical benefit of ensuring that the rights of content owners are secured in a digital content distribution system.

As to claim 17, Chung and Downs disclose wherein the digital format player device includes a personal portable playback device (portable multimedia player; see Chung at Figs. 1 and 2; column 1, lines 20-30).

As to claim 18, Chung and Downs disclose wherein the purchase system makes a copy of the user-selected entertainment media from a database of entertainment media and transfers a copy to the portable digital storage module via a point of purchase module (see Downs at page 9, line 60-column 10, line 35 and column 6, lines 35-49).

As to claim 19, Chung and Downs disclose wherein the encoding step is characterized by access instructions that grant permission to the digital format player to play the entertainment media a finite number of times (see Downs at column 7, lines 41-55, column 20, lines 42-50 and column 61).

As to claim 20, Chung and Downs disclose wherein the retrieving step is characterized by permission being granted to the digital format player to access the entertainment media for a finite period of time (see Downs at column 61).

As to claim 21, Chung and Downs disclose wherein at least a portion of a first entertainment media and at least a portion of a second entertainment media are stored in a common memory location (see Chung at column 1, lines 37-40, column 2, line 56-column 3, line 20).

As to claims 23, 28 and 31, while Chung and Downs disclose a memory, they fail to specifically disclose a disc drive data storage device.

The examiner takes Official Notice that it was notoriously well known in the art at the time of invention by applicant to utilize a disc drive storage device to store data, which are widely known and used to provide long term storage for data, for the typical benefit of taking advantage of a well-known storage device for long-term storage.

It would have been obvious to one of ordinary skill in the art at the time of invention by applicant to modify Chung and Downs' system to include a disc drive data storage device for the typical benefit of taking advantage of a well-known storage device for long-term storage.

As to claim 24, Chung and Downs discloses wherein the storing step is characterized by the entertainment media comprising audio data (see Chung at column 1, lines 6-14).

As to claim 25, Chung and Downs disclose wherein the storing step is characterized by the entertainment media comprising video data (see Chung at column 1, lines 6-14).

As to claim 26, Chung and Downs disclose wherein the encoding step is characterized by a predetermined association between a user-selected purchase price for the entertainment media and the corresponding access instructions (see Downs at column 61).

As to claim 27, Chung and Downs disclose wherein the encoding step is characterized by access instructions that grant permission only to one or more predefined digital format player devices (see Downs at column 11, lines 40-55).

As to claim 29, Chung and Downs disclose wherein the database comprises a cable/satellite television network (see Downs at column 8, lines 42-53).

As to claim 30, Chung and Downs disclose wherein the point of purchase module comprises a cable/satellite receiver (see Downs at column 6, lines 36-48).

As to claim 32, Chung and Downs disclose automatically deleting the entertainment media from the memory in relation to the permission expiring (see Downs at column 11, lines 40-49).

8. Claim 22 is rejected under 35 U.S.C. 103(a) as being unpatentable over Chung and Downs as applied to claim 1 above, and further in view of Gibson et al. (Gibson) (5,557,596) (of record).

As to claim 22, while Chung and Downs disclose storing the entertainment media, they fail to specifically disclose an atomic resolution storage device.

In an analogous art, Gibson discloses the use of an atomic resolution storage device (Figs. 1A-C; column 1, line 63-column 2, line 33) as opposed to conventional storage technologies (column 1, lines 14-21) for the typical benefit of providing ultra-high density storage with fast access times and high data rates (column 1, lines 52-62).

It would have been obvious to one of ordinary skill in the art at the time of invention by applicant to modify Chung and Downs' system to include wherein the memory is characterized as an atomic resolution storage device, as taught by Gibson, for the typical benefit of taking advantage of the benefits provided by an atomic resolution storage device, such as fast access times and high data rates combined with ultra-high density storage.

9. Claims 9, 10 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chung in view of Katayama et al. (Katayama) (6,651,212) and Downs.

As to claim 9, while Chung discloses a portable storage module (column 2, lines 55-62 and column 1, lines 37-40) comprising:

a pocket size enclosure that is removably connectable to a digital format player device (flash memory or multimedia card; Fig. 3; column 2, lines 56-62) in a data transfer relationship (see Fig. 3; column 2, lines 50-60 and column 1, lines 34-40 and lines 56-62),

a memory in the enclosure for storing and retrieving data (column 2, lines 50-62), he fails to specifically disclose a controller in the enclosure for executing instructions stored in the memory for granting the digital format player device access to selected data stored in the memory according to a predefined limit of authorized playings of the selected data.

In an analogous art, Katayama discloses wherein a removable flash memory device (Fig. 1; 101) comprising controller logic (102) for operating the storage device and communicating between the memory component (111-114) and the communications interface (105-106) (Fig. 1; column 10, lines 10-37), for the typical benefit of reducing the size and weight of the memory by integrating the controller and memory into a single chip (column 2, lines 17-23).

Additionally, in an analogous art, Downs discloses a content delivery system (see Figs. 1A-D) wherein digital content is downloaded onto a portable media player (column 6, lines 35-48) which is encoded with access instructions corresponding to a predefined

limit of authorized playings of the entertainment media (column 11, lines 30-55 and column 7, lines 41-55) to allow retrieval of the entertainment media in accordance with a permission granted by the access information (column 11, lines 30-55) for the typical benefit of ensuring that the rights of content owners are secured in a digital content distribution system (column 1, lines 50-60 and column 2, lines 26-34).

It would have been obvious to one of ordinary skill in the art at the time of invention to modify Chung's system to include a controller in the enclosure for executing instructions stored in the memory, as taught by Katayama, for the typical benefit of reducing the size and weight of the memory by integrating the controller and memory into a single chip.

Additionally, it would have been obvious to one of ordinary skill in the art at the time of invention by applicant to modify Chung and Yamagata's system to include instructions for granting the digital format player device access to data stored in the memory according to a predefined limit of authorized playings of the selected data, as taught by Downs, for the typical benefit of ensuring that the rights of content owners are secured in a digital content distribution system.

As to claim 10, Chung, Katayama and Downs disclose a communication interface (see Katayama at Fig. 1) subject to the controller (Fig. 1; column 10, lines 13-37) in transferring data from the memory to the digital format player device (see Katayama at (Fig. 1; column 10, lines 13-37).

As to claim 15, Chung, Katayama and Downs disclose wherein the memory is configured for subsequently storing data wherein different data was previously stored (see Chung at column 2, lines 56-62).

10. Claims 6 and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chung and Downs as applied to claim 1 above, and further in view of Yamagata.

As to claim 6, while Chung and Downs disclose wherein storing the digitally formatted movie further comprises providing the portable digital storage module with a communication interface (inherently present to allow the memory to interface and communicate with the player; see Chung at Fig. 1; column 2, lines 56-62), they fail to specifically disclose wherein the storage module has a power supply.

In an analogous art, Yamagata discloses a portable storage device (100) being coupled to a power supply (power supply circuit 150 and battery 130) for the typical benefit of allowing the memory to record and reproduce information without the need for an external power supply (column 2, lines 39-40).

It would have been obvious to one of ordinary skill in the art at the time of invention to modify Chung and Downs' system to include the storage module having a power supply, as taught by Yamagata, for the typical benefit of allowing the memory to record and reproduce information without the need for an external power supply.

As to claim 7, Chung, Downs and Yamagata disclose wherein the retrieving step is characterized by a controller logic executing the access instructions stored in the memory (see Chung at column 2, lines 50-62).

11. Claims 11-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chung, Katayama and Downs as applied to claim 9 above, and further in view of Gibson.

As to claim 11, while Chung, Katayama and Downs disclose a memory, they fail to specifically disclose wherein the memory is characterized as an atomic resolution storage device comprising:

a field emitter fabricated by semiconductor microfabrication techniques capable of generating an electron beam current; and

a storage medium in proximity to the field emitter and having a storage area in one of a plurality of states to represent the information stored in the storage area.

In an analogous art, Gibson discloses the use of an atomic resolution storage device (Figs. 1A-C; column 1, line 63-column 2, line 33) as opposed to conventional storage technologies (column 1, lines 14-21), the atomic resolution storage device comprising a field emitter fabricated by semiconductor micro-fabrication techniques capable of generating an electron beam current (see Gibson at column 2, line 65 - column 3, line 29), and a storage medium in proximity to the field emitter and having a storage area in one of a plurality of states to represent the information stored in the

storage area (see Gibson at column 3, lines 1-5) for the typical benefit of providing ultra-high density storage with fast access times and high data rates (column 1, lines 52-62).

It would have been obvious to one of ordinary skill in the art at the time of invention by applicant to modify Chung, Katayama and Downs' system to include wherein the memory is characterized as an atomic resolution storage device comprising: a field emitter fabricated by semiconductor microfabrication techniques capable of generating an electron beam current; and a storage medium in proximity to the field emitter and having a storage area in one of a plurality of states to represent the information stored in the storage area, as taught by Gibson, for the typical benefit of taking advantage of the benefits provided by an atomic resolution storage device, such as fast access times and high data rates combined with ultra-high density storage.

As to claim 12, Chung, Katayama, Downs and Gibson disclose an effect being generated when the electron beam current bombards the storage area, wherein the magnitude is dependent on the state of said storage, and wherein storage data is read by measuring the magnitude of the effect (see Gibson at column 5, line 64 - column 6, line 10).

As to claim 13, Chung, Katayama, Downs and Gibson disclose the atomic resolution storage module further comprising a plurality of storage areas on the storage medium, each storage area in one of a plurality of states to represent information stored in the storage area (see Gibson at column 5, line 64 – column 6, line 10), and a micro

fabricated mover in the storage device for positioning various areas to be bombarded by the electron beam current (see Gibson at column 6, lines 2-10).

As to claim 14, Chung, Katayama, Downs and Gibson disclose the atomic resolution storage module further comprising a plurality of said field emitters (see Gibson at column 2, line 65 - column 3, line 5), with each emitter fabricated by semiconductor micro fabrication techniques capable of generating an electron beam current (see Gibson at column 3, lines 5-20), with each emitter space apart, and with each emitter being responsible for a number of storage areas such that said emitters can function in parallel to increase the data rate of the storage device (see Gibson at column 3, line 57 - column 4, line 20).

Conclusion

12. The following are suggested formats for either a Certificate of Mailing or Certificate of Transmission under 37 CFR 1.8(a). The certification may be included with all correspondence concerning this application or proceeding to establish a date of mailing or transmission under 37 CFR 1.8(a). Proper use of this procedure will result in such communication being considered as timely if the established date is within the required period for reply. The Certificate should be signed by the individual actually depositing or transmitting the correspondence or by an individual who, upon information and belief, expects the correspondence to be mailed or transmitted in the normal course of business by another no later than the date indicated.

Certificate of Mailing

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Please refer to 37 CFR 1.6(d) and 1.8(a)(2) for filing limitations concerning facsimile transmissions and mailing, respectively.

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to James Sheleheda whose telephone number is (571) 272-7357. The examiner can normally be reached on 9:00-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chris Kelley can be reached on (571) 272-7331. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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